

### **REMARKS**

By the above amendment, independent claim 1 and dependent claim 4 have been canceled, with claim 5 being written in independent form incorporating the features of parent claims 1 and 4 therein. Thus, in addition to the features of claims 1 and 4, claim 5 written in independent form recites the feature of "designating said defect candidate location data displayed in map format on said display map, and thereby displaying an image of a defect candidate corresponding to ~~this~~ the designated location on said screen and amended to overcome possible informalities". Dependent claims 2 and 3 have been amended to depend from claim 5. Additionally, independent claims 6 and 16 have been amended to recite the features of dependent claims 7-9 and 17-19, respectively, which dependent claims have been canceled and such claims now recite features corresponding to the features set forth in claim 5, while being amended to clarify other features of the present invention. Further, other claims have been amended to clarify features thereof including amendment of claim 21 to depend from claim 20.

As to the objection of claim 21 as lacking antecedent basis, applicants submit that by the present amendment of claim 21, changing the dependency from claim 16 to claim 20, antecedent basis is now provided for "said changed threshold value data" and the objection to claim 21 should now be overcome.

As to the rejection of claims 1-8 and 12-14 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,047,083 issued to Mizuno and the rejection of claims 6-9, 13 and 15-24 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,539,106 issued to Gallarda et al, such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully submitted.

At the outset, as to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102

requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Turning to independent claims 5 and 6, as noted above, claim 5 recites the feature of designating the defect candidate location data displayed in map format on the display map, and thereby displaying an image of a defect candidate corresponding to the designated location on the screen, while independent claim 6, as amended, recites the feature of displaying the inputted defect candidate data on a screen in map format, and displaying on the screen an image of the defect candidate designated on the map displayed on the screen. As such, claim 6 has been amended to recite features similar to that recited in claim 5.

In setting forth the rejection based upon Mizuno, the Examiner contends that "As per claim 5, Mizuno discloses the step of displaying an image of a defect candidate designated in the map displayed on the screen (col. 5, lines 37-39; see fig. 6b)". Applicants submit that the portions of Mizuno referred to by the Examiner fail to disclose the aforementioned features of claim 5 and therewith claim 6 in the sense of 35 U.S.C. 102. In this regard, it is noted that the features of claim 6 represent features as recited in the claims 7-9 which have been incorporated therein, with claims 7-9 being canceled and corresponding to the features of claim 5. Applicants note that col. 5, lines 37-39 of Mizuno, state:

The reference SEM image and a subtracted image obtained by the above comparing step are overlapped and displayed on the display screen...

Applicants submit that this disclosure does not provide for the aforementioned recited feature of claim 5 and the features of the other independent claims as set forth. Likewise, as described in col. 7, lines 19-30 of Mizuno, Fig. 6b shows the results of the defect classification overwritten on the specified points to be inspected on the wafer map. Hereagain, applicants submit that such does not provide the claimed features of claim 5, as discussed above, in the sense of 35 U.S.C. 102. As noted in the decision of In re Robertson, supra, each and every feature of the claimed invention must be disclosed in the reference, and if the Examiner contends that such features are inherent in Mizuno, possibilities or probabilities is not sufficient to support a rejection under 35 U.S.C. 102. Applicants also note that Mizuno is not properly utilizable under 35 U.S.C. 103 in light of the provisions of 35 U.S.C. 103(c), wherein Mizuno and the present application are commonly assigned. Thus, applicants submit that independent claims 5 and 6, as amended, patentably distinguish over Mizuno in the sense of 35 U.S.C. 102, noting that claim 9 which features are now incorporated into claim 6 and are also recited in claim 5, provide "wherein the defect candidate whose image is displayed on said screen, is designated on this screen" with the Examiner not rejecting claim 9 based upon Mizuno. Accordingly, applicants submit that independent claims 5 and 6 and the dependent claims patentably distinguish over Mizuno in the sense of 35 U.S.C. 102 and should be considered allowable thereover.

With regard to Gallarda et al, the Examiner contends with regard to claims 7-9 that Gallarda et al discloses the recited features noting that such features have been incorporated into claim 6 which correspond to the features of claim 5. It is noted that with respect to claim 16, the Examiner has provided a similar analysis in relation to claims 17-19 and applicants submit that Fig. 3 of Gallarda et al as well as col. 5, lines 12-14 and col. 6, lines 32-35 thereof, fail to disclose the recited features of

claims 6 and 16, as amended, in relation to displaying the input defect candidate data on a screen in map format and displaying on the screen an image of the defect candidate designated on the map displayed on the screen. Applicants submit that such features are not disclosed in the sense of 35 U.S.C. 102, and Gallarda et al, as pointed out above in relation to the decision of In re Robertson, supra, the recited features must be shown in a single reference or inherent therein. Applicants submit that such features are not disclosed by Gallarda et al in the sense of 35 U.S.C. 102, such that independent claims 6 and 16, as amended, patentably distinguish over Gallarda et al in the sense of 35 U.S.C. 102 and should be considered allowable thereover. Thus, independent claims 6 and 16 and the dependent claims should be considered allowable at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.41125X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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